

The Examiner and Applicants' attorney agreed that the illustrative object of a biological life mouse described in the present invention is different from the mechanical computer mouse described in Maki (at column 2, lines 20-26 of Maki). Accordingly, Claim 13 is also in condition for allowance.

5 The Applicants thank the Examiner for the telephonic interview.

Claim Rejection under 35 U.S.C. § 103

The office action rejected Claims 1-5, 10-29 and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over Maki et al (U.S.6,072,903) ("Maki") in view of Hsieh (U.S. 5,546,439) ("Hsieh"). Without admitting that Maki and Hsieh are prior art and reserving the
10 right to establish that Maki and Hsieh are not prior art, Applicants respectfully submit that the present invention is patentable over Maki in view of Hsieh because even if they were combined, the combination would still fail to disclose all limitations claimed in the present application. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180
15 USPQ 580 (CCPA 1974). MPEP Section 2143.03.

To expedite the allowance of the present application, Claims 1 and 16 have been amended to more specifically claim the present invention. Amended Claim 1 recites in part:

to characterize activity of said object of interest based on analysis of changes in said position and said shape over time . . .

20 Also, amended claim 16 recites in part:

characterizing said activity of said foreground object based on comparison of said classifications to activity of a standard object . . .

Examples of such characterization are provided at page 22 of the application including characterizations such as eating, running and sleeping. In contrast, Maki is directed to
25 problems in creating three-dimensional (3-D) models of objects and to enabling 3-D sensuous

pointing. Maki is thus directed to a system and method “used for three-dimensional CAD (computer-aided design) for aiding in designing industrial parts and so on.” See column 1 of Maki. Moreover, Hsieh is directed to a system for producing incremental tomographic images of an object from projection data acquired in a helical scan. See abstract of Hsieh.

- 5 The Applicants respectively submit that neither Maki nor Hsieh discloses or suggests a system that is configured to determine a position and shape of an object of interest from video images and to characterize activity of said object of interest based on analysis of changes in said position and said shape over time.

The Applicants respectfully submit that a desired outcome that the invention provides cannot be used as the motivation to combine the references if there is no such teaching in the references. The Applicants respectfully disagree with the assertion made in the Office Action that “it would have been obvious to a person of ordinary skill in the art at time the invention was made, to modify Maki et al invention according to the teachings of Hsieh.” See page 3 of the Office Action. Since neither Maki nor Hsieh teaches or suggests a combination
10 between Maki and Hsieh, the Applicants contend that there is no teaching to combine.
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Even assuming for the sake of argument that Maki and Hsieh were combined, the combination would still fail to teach or suggest a system of characterizing activity of said object of interest based on analysis of changes in said position and said shape over time as claimed in the present invention. Accordingly, one of ordinary skill in the art would not
20 combine Maki and Hsieh, because even if they were combined, the combination would still fail to disclose or suggest all limitations disclosed in claimed invention. Therefore, Claims 1 and 16 are patentable over Maki in view of Hsieh under Section 103.

Furthermore, since Claims 2-5 and 10-15 depend from Claim 1, and 17-29 and 31-35 depend from Claim 16, Claims 2-5, 10-15, 17-29 and 31-35 should be patentable because
25 Claims 1 and 16 are in condition for allowance as discussed earlier. The Federal Circuit has

ruled that if independent claims are valid, the claims that depend from the independent claims should also be valid as matter of law. See *Jenric/Pentron, inc. v. Dillon Co.*, 205 F.3d 1377, 1382 (Fed. Cir. 2000).

CONCLUSION

5 All pending claims in the present application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If there are any additional charges concerning this response, please charge to White & Case LLP Deposit Account 23-1703. Applicants thank the Examiner for carefully examining the present application and if a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Jim Wu at (650)213-0300.

Respectfully submitted,

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